

Doc Code: AP.PRE.REQ

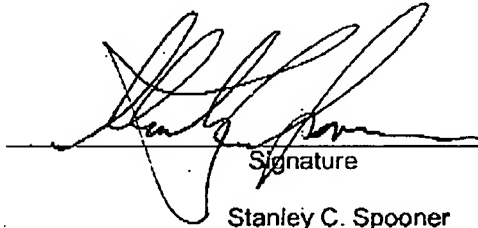
MAR 07 2008

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		SCS-540-560
Application Number	Filed	
10/529,227	March 25, 2005	
First Named Inventor		
Harris		
Art Unit	Examiner	
1797	N. Turk	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> Applicant/Inventor <input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> Attorney or agent of record 27,393 (Reg. No.) <input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> Total of 1 form/s are submitted.</p>		


Signature
Stanley C. Spooner

Typed or printed name
703-816-4028

Requester's telephone number
March 7, 2008

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.

RECEIVED
CENTRAL FAX CENTER
MAR 07 2008

**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the third and non-final rejection mailed October 16, 2007 (Paper No. 20071015).

It is noted that while the previously filed Pre-Appeal Brief Request for Review was denied by the panel on April 5, 2007, Appellant's Appeal Brief was considered and prosecution was reopened with the 3rd Official Action on the merits mailed October 16, 2007. While the Examiner alleges on page 2 under "New Grounds for Rejection" that he "has not removed or added any prior art references" in each of the obviousness rejections of claims 8-10, 11-12, 13-15, 16-20 and 21-22, the Examiner has actually added the Ansuini reference to the Kim reference and merely copied the previous rejections. Accordingly, the previously filed Supporting Statement is updated to reflect the added reference by the Examiner.

**Error #1. The Examiner erroneously combines Kim
and Ansuini and other references in a rejection of
claims 1-22**

In the outstanding third action, the Examiner rejects all pending claims as being obvious over the combination of the Kim and Ansuini references, by themselves or in combination with other references. Claims 2-22 all depend directly from independent claim 1. As noted above, the Kim reference teaches a plurality of straight tracks and Ansuini teaches a single curved track. The Examiner alleges that it would be obvious to take the "plurality" from Kim and the "curved" aspect from Ansuini and combine these features to establish a *prima facie* case of obviousness of the claimed "plurality of corrosive tracks" each of which has "a plurality of mutually inverted

HARRIS et al.
Appl. No. 10/529,227
March 7, 2008

generally U-shaped bends” as taught only by Appellants specification. This does not set out a *prima facie* case of obviousness of the combination.

The Court of Appeals for the Federal Circuit has consistently held that “the PTO has the burden under §103 to establish a *prima facie* case of obviousness.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Court held that the PTO “can satisfy this burden only by showing some objective teaching in the prior art.” Here, the Examiner has shown no objective teaching in either the Kim or Ansuini references for Applicants’ claimed combination of a “plurality of corrosive tracks” each of which includes the “generally U-shaped bends.”

Error #2. The Examiner fails to articulate any rationale for picking and choosing elements from the Kim and Ansuini references and then combining them only in the manner taught by Appellant’s claims.

In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1396 (emphasis added).

In the new rejections, the Examiner fails to provide any “explicit” analysis of why one would pick and chose elements from the two different references and then combine them in the manner of claim 1. In fact, the only analysis seems to be directed towards dependent claim 6 and, as will be seen, this is incorrect.

HARRIS et al
Appl. No. 10/529,227
March 7, 2008

The Supreme Court in its *KSR* decision went on to say that it followed the Court of Appeals for the Federal Circuit's advice that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

The Examiner's only basis for combining "in order to provide a corrosive track configuration which saves space" not only fails to meet the Supreme Court's burden but is actually incorrect. Firstly, the Examiner's quote is a reference to a limitation contained in claim 6 and, even if it were correct, it would not be a reason or motivation to combine the elements of claim 1 (not having anything to do with the claim 6 "minimum radius of curvature"). Secondly, the claim 6 limitation requires a specific "minimum radius of curvature" and thus the claim 6 limitation requires more space than an arrangement with a less than minimum radius of curvature, i.e., just the opposite of the Examiner's rationale. Thus, the allegation of "motivation" for combining the two references fails as being illogical.

In any event, the Examiner, at best, provides only a "mere conclusory statement" as to motivation and fails to meet the Supreme Court requirement of an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Because "the PTO has the burden under § 103 to establish a *prima facie* case of obviousness" and the Examiner has failed to meet his burden, the rejection fails. *Id.* at *In re Fine*. Accordingly, the obviousness rejection of independent claim 1 (and all claims dependent thereon) fails because no *prima facie* case has been made out by the Examiner.

HARRIS et al
Appl. No. 10/529,227
March 7, 2008

Error #3. The Examiner errs in apparently ignoring that Kim's teaching of only straight paths and Ansuini's teaching of only a single curved path would lead one of skill in the art away from Claim 1's requirement of a "plurality of corrosive tracks" with each track including "a path which includes a plurality of mutually inverted generally U-shaped bends"

The Examiner's admission on page 3 that "Kim does not disclose each bend . . ." is appreciated, but he fails to admit that Kim teaches only a plurality of straight line interconnections. The Examiner also fails to admit that Ansuini has no teaching of "a plurality of corrosive tracks" and instead teaches a single serpentine track. Thus both references contain teachings which in their context would lead one of ordinary skill away from the claim 1 combination of features thereby rebutting any *prima facie* case of obviousness.

The Court of Appeals for the Federal Circuit in *In re Fine* went on to say that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." *Id.*, at 1599. As noted above, the Kim reference in teaching straight "thin line 41" would lead one of ordinary skill in the art away from Applicants' path which includes "generally U-shaped bends." Ansuini's teaching of using only a single curved corrosive track, leads away from the claimed plurality of tracks.

The Examiner has not rebutted the presumption of Kim and Ansuini teaching away from the cited combinations by any evidentiary showing as to why or how one of ordinary skill in the art would think to substitute "generally U-shaped bends" for the straight "thin line 41" segments in Kim.

SUMMARY

There is no dispute that Kim fails to disclose the claim 1 limitation of "generally U-shaped bends" and instead teaches only straight connections. There is no dispute that Ansuini

HARRIS et al
Appl. No. 10/529,227
March 7, 2008

fails to disclose a plurality of corrosive tracks and instead teaches only a single curved track. The Examiner does not allege any recognition of any benefit for combining these references in the manner of independent claim 1. The Examiner fails to meet his burden of providing an "explicit" analysis explaining why one of ordinary skill would pick and choose elements from the prior art and then combine them in the manner of Claim 1. Finally, the Examiner fails to appreciate that the Kim's teaching of straight "thin line 41" and Ansuini's teaching of only a single curved track, would each lead those of ordinary skill away from the "generally U-shaped bends" in each of a "plurality of corrosive tracks" and thereby rebutting any prima facie case of obviousness (even if some "explicit" analysis were forthcoming from the Examiner). Because claim 1 is clearly non-obvious in view of the prior art, claims 2-22 dependent thereon are non-obvious as well.

As a result of the above, there is simply no support for the rejection of Applicants' independent claim 1 or claims dependent thereon under 35 USC §102 and/or §103. Applicants again respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.